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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,890	06/29/2001	Juha Salo	367.40305X00	4950

20457 7590 04/14/2005

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EXAMINER

NGUYEN, DAVID Q

ART UNIT

PAPER NUMBER

2681

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,890

Applicant(s)

JUHA SALO ET AL

Examiner

David Q Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 18-21 and 38-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 18-21 and 38-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 01/24/05 have been fully considered but they are not persuasive.

In response to applicant's Remarks, applicants also argue: "However, it is submitted that Tegler et al do not disclose the foregoing subject matter which requires the signal which is received by the GSM receiver associated with the set top box to receive a second signal conveying complementary information related to a first signal transmitted from the second communication network."

Examiner respectfully disagrees because Tegler et al do disclose the signal received by the GSM receiver associated with the set top box to receive a second signal conveying complementary information related to a first signal transmitted from the second communication network (see col. 3, lines 34-59 and fig. 1). In fig. 1 of Tegler et al shows a mobile terminal having a first receiver for receiving a first signal from a first communication network (from IC to DC to network to STB); a second receiver within said mobile terminal for receiving a second signal (fig. 1; cellular signal) conveying complementary information relating to said first signal transmitted from a second communication network (see col. 3, lines 34-42; the second network: cellular network).

Applicants also argue: " The Examiner's reference to column 3, lines 25-59, does not describe a controller for configuring the broadband receiver according to complementary information and does not disclose complementary information pertaining to configuration of the receiver as recited in claim 2.

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Examiner respectfully disagrees because claim 2 only recites a controller for configuring said first receiver according to said complementary information (see claim 2). Moreover, Tegler et al discloses a control unit in the set-top-box receiver (see fig. 4) receiving GSM telephone signal or incoming broadband signal according to information (see fig. 2 and column 3, lines 25-59).

Applicants also argue: "Claim 3 further claim 1 in reciting the first receiver is unable to receive said first signal in response to said complementary information."

Examiner respectfully disagrees because Tegler et al discloses the receiver receiving the GSM signal or incoming broadband signal according to complementary information (see fig. 2 and column 3, lines 25-59).

Applicants also argue: "It is submitted that column 3, lines 60 to column 4, line 5, do not describe user preference".

Examiner respectfully disagrees because Tegler et al discloses GSM incl. SIM in the receiver to read information, authenticating and PIN of the user (see fig. 2 and column 3, lines 60 to column 4, line 5). It is apparent that Tegler et al discloses storage means for storing user preferences.

Applicants also argue: "there is no disclosure of storage of user preferences and moreover, there is no disclosure in Tegler et al of enabling the first receiver in dependence on stored user preferences."

Examiner respectfully disagrees because Tegler et al discloses a storage of user preferences (see explanation above), and enabling the first receiver in dependence on stored user preferences (see col. 3, line 65 to col. 4, line 5). Tegler et al discloses checking user's Pin and

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authentication before providing service to user as requested (see col. 3, line 65 to col. 4, line 5).

It is apparent that Tegler et al discloses a storage of user preferences and enabling the first receiver in dependence on stored user preferences.

Applicants also argue: "column 3, line 25 to column 4, line 5, do not disclose personal data with data being combined with generic data forming said content of said first signal"

Examiner respectfully disagrees because Tegler et al discloses "User's credit card combined with personal data as PIN and authenticating before providing a service to users". Therefore, Tegler et al discloses personal data with data being combined with generic data forming said content of said first signal (see column 3, line 25 to column 4, line 5).

Applicants also argue: "the reference in column 9 pertaining to a set top box displaying schedule information would not motivate a person of ordinary skill in the art to modify Tegler et al to arrive at the subject matter of claims 4 and 40 except by impermissible hindsight."

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-3,5-8, and 10,18-21, and 38-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Tegler et al. (US 6,606,481 B1).

Regarding claims 1, Tegler discloses a mobile terminal (see fig. 1; cellular phone) having a first receiver for receiving a first signal from a first communications network (from IC to DC to network to STB) comprising: a second receiver within said mobile terminal for receiving a second signal (fig. 1; cellular signal) conveying complementary information relating to said first signal from a second communications network (see col. 3, lines 34-42; the second network: cellular network).

Regarding claims 2-3,5-8 and 10, Tegler also discloses a controller for configuring said first receiver according to said complementary information (see col. 3, lines 34-42); wherein said first receiver is enabled to receive said first signal in response to said complementary information (see col. 3, lines 34-42); storage means for storing user preferences (fig. 2; SIM card); decision means for deciding whether said second signal should enable said first receiver in dependence on the stored user preferences (see col. 3, line 60 to col. 4, line 5); wherein said first signal is a digital video broadcasting (DVB) signal, and said first receiver is a digital video broadcasting (DVB) receiver (see fig. 2 and col. 3, lines 25-59); wherein said second signal is a global system for mobile (GSM) signal, and said second receiver is a global system for mobile (GSM) receiver (see fig. 2 and col. 3, lines 25-59); wherein the first signal includes a data file, said terminal being actuable in response to said complementary information to receive said data file (see fig. 2 and col. 3, lines 25-59).

Regarding claims 18-21, Tegler also discloses a method of receiving a first signal by a mobile terminal from a first communications network (see explanation in claim 1) comprising: receiving a second signal with said mobile terminal conveying complementary information relating to said first signal transmitted from a second communications network (see explanation in claim 1); receiving said first signal in accordance with said complementary information (see explanation in claim 2); storing user preferences (see explanation in claim 5); deciding whether said second signal should be received in dependence on said stored user preferences (see explanation in claim 6).

Regarding claim 38, Tegler also discloses a method of receiving a first signal from a first communications network comprising receiving a second signal conveying complementary

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information relating to said first signal from a second communications network, and combining said information from said second signal with content in said first signal (see fig. 2 and col. 3, lines 25-59).

Regarding claim 39, Tegler also discloses said complementary information comprises personal data, said data being combined with generic data forming said content of said first signal (see fig. 2 and col. 3, line 25 to col. 4, line 5);

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tegler et al. (US 6,606,481 B1) in view of Ellis et al. (US 6,774,926).

Regarding claim 4, Tegler's terminal does not mention wherein said complementary information comprises schedule and configuration data. However, Ellis et al mention information comprises schedule and configuration data (see col. 9, lines 31-46). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Ellis et al to Tegler et al so that user can select program as desired.

Regarding claim 40, Tegler's method mentions wherein said second signal further comprises configuration data relating to said first signal identifying said content (see fig. 2 and col. 3, line 25 to col. 4, line 5). Tegler's method does not mentions said second signal comprising schedule. However, Ellis et al mention second signal comprising schedule (see col. 9, lines 31-

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46). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Ellis et al to Tegler et al so that user can select program as desired.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tegler et al. (US 6,606,481 B1) in view of Yuen (WO 00/18123).

Regarding claim 9, Tegler's terminal does not mention said second signal is a general packet radio service (GPRS) signal, and said second receiver is a general packet radio service (GPRS) receiver. However, Yuen discloses said second signal is a general packet radio service (GPRS) signal, and said second receiver is a general packet radio service (GPRS) receiver (see abstract; page 4, lines 4-30 and fig. 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Yuen to Tegler et al so that user can view images on the mobile phone.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Nguyen whose telephone number is 571-272-7844. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moise Emmanuel can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DN
David Nguyen


ERIKA A. GAFF
PRIMARY EXAMINER